

REMARKS

Applicant acknowledges receipt of an Office Action dated December 13, 2007. In this response, Application has amended claim 1 to incorporate the subject matter of claims 2-3. As such, claims 2 and 3 are cancelled without prejudice or disclaimer. Claim 4 is currently amended to correct their dependency, and claim 5 has been redrafted in independent form. New claim 9 is added. Support for new claim 9 may be found in the specification as originally filed, *inter alia*, on page 6, lines 1-5. Following entry of this amendment, claims 1 and 4-9 remain pending in the application.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection Under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action, the PTO has rejected claims 1-12 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failure to particularly point out and distinctly claim the subject matter regarded as the invention. In this response, Applicant has amended claim 1 to remove the phrases “in particular for a motor vehicle” and “in particular oil cooler.”

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections under § 112.

Rejection Under 35 U.S.C. § 102

On page 2 of the Office Action, the PTO has rejected claims 1 and 6 under 35 U.S.C. § 102(b) as allegedly being anticipated by French Patent FR 2,251,277 to Villeval (hereafter “FR ‘277”). In addition, on page 2 of the Office Action, the PTO has rejected claims 1-2, 4, and 6-8 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 6,082,449 to Yamaguchi *et al.* (hereafter “Yamaguchi”). Applicant traverses these rejections for at least the reasons set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Here, FR '277 and Yamaguchi each fail to disclose a coolant radiator comprising "a coolant outlet box comprising ...an oil cooler comprising ... a front gap between the oil cooler and the front wall, and a rear gap between the oil cooler and the rear wall, wherein the rear gap is larger than the front gap" as recited in claim 1.

For at least this reason, Applicant submits that the outstanding rejections based upon the FR '277 and Yamaguchi have been overcome and ought to be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under § 102.

Rejection Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 7-8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamaguchi. In addition, on page 4 of the Office Action, the PTO has rejected claim 3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamaguchi in view of French Patent FR 2,549,593 to Mansoux (hereafter "FR '593"). Applicant traverses these rejections for at least the reasons set forth below.

The framework for the objective analysis for determining obviousness under §103 requires:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Teleflex, Inc. v. KSR Int'l Co., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

Here, Yamaguchi and FR '593, whether taken individually or in combination, fail to teach or suggest that "a coolant outlet box comprising ...an oil cooler comprising ... a front gap between the oil cooler and the front wall, and a rear gap between the oil cooler and the rear wall, wherein the rear gap is larger than the front gap" as recited in claim 1.

Yamaguchi discloses "a mounting structure for mounting an oil cooler to a heat

exchanger tank,” but fails to teach or suggest an oil cooler wherein “the rear gap is larger than the front gap” as currently claimed. As admitted by the PTO on page 4 of the Office Action, “Yamaguchi et al lacks a larger gap between the connection wall of the coolant box and auxiliary heat exchanger than the opposite wall.” Figures 1 and 8-9 of Yamaguchi each depict an oil cooler where the front gap is equal in size to the rear gap. Furthermore, the disclosure of Yamaguchi does not teach or suggest any information regarding the size of the front gap or the rear gap, or the size relation between the front gap and rear gap.

FR ‘593 does not teach or suggest an oil cooler with a coolant outlet box wherein “the rear gap is larger than the front gap” as currently claimed, failing to resolve this deficiency of Yamaguchi. As illustrated in the Figure of FR ‘593, a secondary heat exchanger is present within a radiator tank, and is connected to the inside of the radiator tank via screws and the bearing plate. The secondary heat exchanger of FR ‘593 is located in a coolant outlet box as presently claimed, but rather is located completely within the radiator tank.

Furthermore, Applicant respectfully disagrees with the PTO’s assertion on page 4 of the Office Action that “Mansoux discloses a radiator comprising a coolant box 1 containing an oil cooler 4 having a connection 19 on a wall thereof, and a larger gap between the connection wall of the coolant box and auxiliary heat exchanger than the opposite wall for the purposes of accommodating the bearing plate 11 with seals 17, 18.” Rather, FR ‘593 does not disclose the relative size or spacing between the auxiliary heat exchanger and the side walls of the radiator tank, and the Figures are not indicated as being drawn to scale. “When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP 2125; *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000).

For at least these reasons, Applicant submits that the outstanding rejection based upon the combination of Yamaguchi and FR ‘593 is improper and ought to be withdrawn.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 3-9, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

Allowable Subject Matter

Applicants acknowledge, with appreciation, the PTO's indication, on page 5 of the Office Action, that claim 5 would be allowable if rewritten in independent form including all of the subject matter of the base claim and any intervening claims. In this response, Applicants have redrafted claim 5 in independent form.

Newly Added Claim

In this response, Applicant has added claim 9 which depends from claim 1. Applicant believes that claim 9 is allowable by virtue of its dependency from independent claim 1 and also because of the additional features recited claim 9.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Attorney Docket No. 016906-0495
Application No. 10/575,465

Respectfully submitted,

Date 4/11/08

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